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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,106	02/01/2001	Gerard A. Mourou	30275/939A	4544

4743 7590 09/25/2012
MARSHALL, GERSTEIN & BORUN LLP
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EXAMINER

EVANS, GEOFFREY S

ART UNIT	PAPER NUMBER
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3742

NOTIFICATION DATE	DELIVERY MODE
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09/25/2012

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mgbdoCKET@marshallip.com

Office Action Summary	Application No. 09/775,106	Applicant(s) MOUROU ET AL.	
	Examiner GEOFFREY S. EVANS	Art Unit 3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2012.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 46-50,52-54,56-66,68-80 and 106-113 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 46-50,52-54,56-66,68-80 and 106-113 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. This office action is in response to the amendment of 13 July 2012.
2. Since a Reexam Certificate has been issued, Applicant must submit an amendment based on the results of the reexam proceeding. (See MPEP1449.01(B)(1)). Respectfully suggest an amendment that states:: "Please delete all claims in the prosecution and enter the following set of claims:" Present claims 1-64 as they now exist in the reexamined patent (except claim 6, which as cancelled in the reissue, should be presented in strike-through). This is because they relate back by virtue of the reexam certificate. They should be presented without any underlining and bracketing in their text (as if it were done via a certificate of correction). The claims 1-64 should be shown in brackets, except claim 6, which is presented in strike-through, due to their cancellation. The current claims 46-50,52-54,56-66 and 68-80 and 106-113 should be presented as claims 65-98. In the remarks, applicant should state: "Please add claims 1-64, as cancelled (as reflected by their enclosure in brackets) and please enter claims 65-98."
3. Claims 46-50,52-54,56-66, 68-80 and 106-113 are rejected under 35 U.S.C. 251 as being broadened in a reissue application. Regarding claim 46, it recites laser ablating or changing properties of an opaque or transparent material but does not require that the characteristic pulse with causes a breakdown by itself as recited in the independent claims of the Reexamination. Similarly all of the other independent claims in this application do not recite the "by itself" language found in the independent claims of the RE37,585F1. Please note that a reexamination certificate US RE37,585 F1 was issued on March 6,2007. Please note that under MPEP Section 1449.01 (B)(3) states that

Art Unit: 3742

generally, further prosecution will be limited to claims narrower than those claims canceled by the reexamination certificate. Any claims added thereafter, which are equivalent in scope to claims canceled by the reexamination certificate, or are broader than the scope of the claims canceled by the reexamination certificate, will generally be deemed as surrendered based on the patent owner's failure to prosecute claims of equal scope and to present claims of broader scope in the reexamination proceeding. The two exceptions to this rule (a) The broader claims in the reissue application can be patentable, despite the fact that the claims in the reexamination are not; and (b) The broader claims in the reissue application could not have been presented in the reexamination proceeding are not applicable.

4. Claim 106 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Multiple independent claim 106 recites dependency upon claims 81,86,91,96 and 101 that have been cancelled.

5. Applicant's arguments filed 13 July 2012 have been fully considered but they are not persuasive. Regarding Applicant's arguments of the effect of RE 37,585 F1 with respect to the rejection under 35 USC 251, the fact that MPEP Section 1449.01 (B) did not exist at the time of the reexamination application is not persuasive. Please note that MPEP Section 1449.01 (B) was not changed due to a change in law or rule by rule making but merely as a change in PTO policy.

6. Applicant's amendment necessitated the new ground(s) of rejection (with respect to claim 106) presented in this Office action. Accordingly, **THIS ACTION IS MADE**

FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Claims 46-50,53-54,56-66,68-80 and 107-113 are allowable over the prior art of record but are rejected under 35 USC 251.

8. Claim 106 is allowable over the art of record but has been rejected under 35 U.S.C. 112, 2nd paragraph and 35 U.S.C. 251, as set forth in this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GEOFFREY S. EVANS whose telephone number is (571)272-1174. The examiner can normally be reached on Mon-Fri 7:30AM to 4:00 PM (flexible).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu Hoang can be reached on (571)-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3742

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GEOFFREY S EVANS/
Primary Examiner, Art Unit 3742